

## **REMARKS**

### **Status of the Claims**

Claims 1-12 are pending in the application. Claims 5, 6, 11 and 12 have been withdrawn from consideration by the Examiner as directed to non-elected subject matter. Claims 13 and 14 have been added. Claims 1-4 and 7-10 stand rejected.

### **Rejection under 35 U.S.C. § 112**

Claims 1-4 and 7-10 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Applicants respectfully traverse this rejection. Applicants respectfully request reconsideration and withdrawal of the rejection with respect to claims 1-4 and 7-10 in view of the following remarks.

Page 2 of the Office Action states “concerning the last two lines of claims 1 and 7, it is unclear as to what structural arrangement ‘wherein the return side filter and the supply side filter share a common housing component.’” Applicants respectfully submit that “wherein the return side filter and the supply side filter share a common housing component” as recited in claims 1 and 7 is definite and adequately supported by the specification. Support for this claimed feature appears throughout the specification including page 2, lines 16-17 which recites “by sharing the common housing component, be it a bottom, top, or side wall ...” Additionally, FIGs. 1-9 depict several embodiments of a fluid filtration assembly including a common housing component. FIGs. 1-4 depict a fluid filtration assembly 10 including a common housing component 16 and according to page 4, lines 19-20 of the specification, “the common housing component 16 is a common bottom.” FIGs. 5 and 6 depict a fluid filtration assembly 110 featuring a “common bottom” housing component 116 as stated on page 6, line 16 of the specification. FIGs. 7 and 9

depict a “common bottom 216” as stated on page 6, line 26 of the specification and “a single common lid 248” as stated on page 6, line 28 of the specification. Applicants respectfully submit that claims 1 and 7 are definite and adequately supported by the specification. In view of the foregoing, Applicants respectfully request withdrawal of the objection to claims 1 and 7 under 35 U.S.C. § 112, second paragraph.

Page 2 of the Office Action further recites “[c]oncerning claims 4 and 10, it is uncertain as to what structure the term ‘bottom’ implies.” Claim 4 recites “[t]he fluid filtration assembly as set forth in claim 1, wherein the common housing component is a bottom.” Claim 10 recites “[t]he vehicle transmission as set forth in claim 7, wherein the common housing component is a bottom.” Applicants respectfully submit that the term “bottom” as used in “wherein the common housing component is a bottom” as recited in claims 4 and 10 is definite and adequately supported by the specification. Support for this claimed feature appears throughout the specification including in FIGs. 1-3 and according to page 4, lines 19-21 of the specification, “[i]n the illustrated embodiments, the common housing component 16 is a common bottom 16 comprising both a return-side pan 24 and a supply-side pan 26 associated, respectively, with the return-side and supply-side filters 18, 20.” Additionally, FIGs. 1-9 depict several embodiments of a fluid filtration assembly including a common housing component. FIGs. 1-4 depict fluid a filtration assembly 10 including a common housing component 16 and according to page 4, lines 19-20 of the specification, “the common housing component 16 is a common bottom.” FIGs. 5 and 6 depict a fluid filtration assembly 110 featuring a “common bottom” housing component 116 as stated on page 6, line 16 of the specification. FIGs. 7 and 9 depict a “common bottom 216” as stated on page 6, line 26 of the specification. Applicants respectfully submit that claims 1 and 7 are definite and adequately supported by the specification. In view of the foregoing,

Applicants respectfully request withdrawal of the objection to claims 4 and 10 under 35 U.S.C. § 112, second paragraph.

The Examiner has also rejected claims 2 and 8 under 35 U.S.C. § 112, second paragraph as unclear with respect to the phrase “relatively small particulates” and has similarly rejected claims 7 and 9 for the phrase “relatively large particulates”. According to the MPEP § 2173.05(b) “the fact that claim language, including terms of degree may not be precise, does not automatically render the claim indefinite. Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.” Applicants respectfully submit that a person of ordinary skill would understand the phrases in question.

Specifically, a person of ordinary skill would understand that the fluid being filtered comprises particulates of varying sizes. Thus, a person of ordinary skill would understand that by “relatively small particulates” it is meant the smaller sized particles with the range of sizes of particulates present in the fluid. Similarly a person of ordinary skill would understand “relatively large particulates” to mean the larger sized particulates within the range of sizes of particulates present. A specific, numerical size is not required for clarity, for the above reason and further at least because a person of ordinary skill understands that a filter separates particulates generally in terms of size. Thus, for example, a person of ordinary skill understands that by indicating that a filter filters “relatively small particles from the return fluid” it is understood that the filter is intended to allow smaller particulates in the group of particulates present in the return fluid to pass through the filter, while preventing other particulates in the return fluid from passing through. Applicants therefore request that the 35 U.S.C. § 112, second paragraph rejection of claims 2, 3, 8, and 9 be withdrawn.

**Rejection under 35 U.S.C. § 102(b)**

Claims 1-4 are rejected under 35 U.S.C. § 102(b) as being anticipated by O'Connor (3,945,208). Applicants respectfully traverse this rejection. Reconsideration and withdrawal of the rejection with respect to claims 1-4 is respectfully requested in view of the following remarks.

Claim 1 recites "the return-side filter and the supply-side filter share a common housing component." O'Connor "relates to a hydraulic system and more particularly to filtering means with a hydraulic fluid reservoir to avoid cavitation of the pump and fluid hammering as the flow rate of the variable displacement pump is varied." *See* Col. 1 lines 5-9. O'Connor provides a single drawing that "illustrates schematically [its] integrated hydraulic fluid system." The drawing includes a coarse suction supply filter 11, a fine return flow filter 7, a surge tank 6, and a reservoir 5. However, this drawing does not disclose the structure or arrangement of the disclosed filters.

O'Connor fails to disclose the feature of "the return-side filter and the supply-side filter share a common housing component" as recited in claim 1. Page 3 of the Office Action states that O'Connor discloses "the return side filter and the supply side filter sharing a common housing component (e.g. the reservoir 5)." Applicants respectfully submit that O'Connor does not disclose "the return side filter and the supply side filter sharing a common housing component (e.g. the reservoir 5)." At best O'Connor discloses a two stage filtration system with a coarse suction supply-side filter and a fine return-side filter, but does so without disclosing additional details with regard to either filter. As stated above, the single O'Connor drawing is a schematic drawing and does not disclose the structural makeup or arrangement of the disclosed filters. As such, O'Connor does not indicate that its reservoir is a housing component, let alone a

common housing component for the filters. In fact, O'Connor suggests that the reservoir cannot be a housing component because O'Connor states that "a reservoir 5 is preferably located in the rear axle housing." Col. 2, lines 42-43. Further, O'Connor does not otherwise disclose the feature of a supply-side filter and return-side filter having a common housing component of claim 1.

In view of the foregoing, withdrawal of the § 102(b) rejection to claim 1 as being anticipated by O'Connor is respectfully requested at least because O'Connor fails to disclose "the return-side filter and the supply-side filter share a common housing component." Claims 2-4 depend from independent claim 1. Therefore it is respectfully submitted that claims 2-4 are patentable for at least the same reasons as discussed in response to the rejection of claim 1 as being anticipated by O'Connor. In light of the foregoing, withdrawal of the § 102(b) rejection of claims 2-4 as being anticipated by O'Connor is respectfully requested.

#### **Rejection under 35 U.S.C. § 103(a)**

Claims 7-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over O'Connor (3,945,208) in view of Agner (6,190,546). Applicants respectfully traverse this rejection. Reconsideration and withdrawal of the rejection with respect to claims 7-10 is respectfully requested in view of the following remarks.

Independent claim 7 recites that "the return-side filter and the supply-side filter share a common housing component." As discussed above, in connection with the 35 U.S.C. § 102 rejection, O'Connor does not disclose use of a return filter and a supply filter with a common housing component having media interposed between the inlet and outlet located in a sump. Agner does not overcome this deficiency. Agner discloses only a single oil suction filter 1 which

is arranged within an oil sump 3 filled with oil. *See* Col. 3, lines 3-4. Accordingly, Agner does not lack or suggest a return filter and a supply filter with a common housing compartment. Thus, the combination of O'Connor and Agner fails to teach or suggest all aspects of claim 7. In light of the foregoing, withdrawal of the rejection to claim 7 as being unpatentable over O'Connor in view of Agner is respectfully requested.

Claims 8-10 depend from independent claim 7. Therefore it is respectfully submitted that claims 8-10 are patentable over O'Connor in view of Agner for at least the same reasons as discussed in response to the rejection of claim 7. In light of the foregoing, withdrawal of the rejection of claims 8-10 as being unpatentable over O'Connor in view of Agner is respectfully requested.

## Conclusion

It is therefore respectfully submitted that the application is in condition for allowance and such action is hereby solicited. No fee is due in connection with the submission of this amendment. In the event this paper is not timely received or a further extension is required, Applicants petition for an appropriate extension of time. Any additional fees may be charged to or overpayment credited to Deposit Account No. 50-2036.

Respectfully submitted,

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**APPENDIX**

**VERSION WITH MARKINGS SHOWING**  
**CHANGES MADE IN THE CLAIMS**

**Please add new claims 13 and 14.**